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EXAMINER

MEHRA, INDER P

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/905,014

Applicant(s)

SPADARO ET AL.

Examiner

Inder P. Mehra

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-53 and 55-58 is/are rejected.
- 7) ☒ Claim(s) 54 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to Amendment dated 6/12/07. Based on this amendment, claim 1, 12, and 26, are amended. Claims 1-58 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4, 6-7, 12-17, 23, 26-27, 32-33, 36, 41-43, 47-48, and 52-53, are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kung et al** (US Patent Application No. 2003/0133558), hereinafter, **Kung** in view of **Gainsboro** (US Patent Application No. 2002/0071537).

For claims 1, 6, 12, 17, 26, **Kung** discloses "a controlled public telephone communications system, **(The IP central station may be configured to store various control and system information such as location, address, and/or configurations of one or more broadband residential gateways 300, as well as other routing and call set-up information, refer to paragraph 0038; configured to manage voice information transfers---, refer to paragraph 0038); comprising,**

- a plurality of telephones at a given site **(The broadband network generally provides interconnection between a plurality of customer locations utilizing**

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various interconnection architectures including Internet Protocol (IP) based network, refer to paragraph 0026);

- a programmable control computer (programming messages and/or computer data between the various devices, refer to paragraphs 0036, 0037, 0055, for switching (paragraphs 0040,0044), accessing (paragraph 0006 and abstract), routing, (paragraph 0037, 40, 44, and 57), timing (paragraph 0044, 48 and 67), billing, (paragraph 35, 39 and 63), and the controlling usage of said telephones (figs. 2 and 3 and paragraphs 27 and 55), said telephones (106, 108, 110 and PSTN) being connected to said computer (200 in fig. 4);
- **As recited by claim 26, a Voice over Internet Protocol (VoIP) gateway for transmitting signals from said telephones into data packets transmitted over----- said control computer, (analog voice may be converted to digital data and packetized for transmission in an appropriate output protocol such as an Internet protocol (IP), refer to paragraph 0028; further, discloses, "the IP central station 200 may also include, for example, one or more of the following gateways:--- a voice gateway (VG) 232, and/or a multimedia gateway (MG) 230. The IP central station 200 may utilize one or more of these gateways to provide centralized system intelligence and control of voice and/or data IP packets, refer to paragraph 0045 and VOIP telephony refer to paragraph 0041).); and**
- switching means operable under control of said programmable computer for selectively connecting said telephone instruments with said Voice over Internet Protocol network (VOIP) network , wherein said telephones are connected to said

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- public switched telephone network only under control of said programmable control computer, (Kung discloses, “programming messages and/or computer data between the various devices, refer to paragraphs 0036, 0037, 0055; “The central router 210 provides for example Ethernet switching and aggregate traffic between servers, gateways and the IP network 120 (Gateway is connected to various telephones, see fig. 1), and/or ATM network 185 backbone, refer to paragraph 0044); and further discloses analog voice may be converted to digital data and packetized for transmission in an appropriate output protocol such as an Internet protocol (IP), refer to paragraph 0028, 142, 144 and 120 in fig. 1));
- a processor-based system coupled to said VoIP gateway and disposed remotely with thereto, said processor-based system providing call control for controlling communications between said plurality of telephone terminals and said user terminals external to said prison facility, (Alternatively, the user may use system memory in IP central (processor) and buffer data remotely, refer to paragraph 0093).
 - an offsite public switched telephone network, as recited by claims 6, and 17, (160 in fig. 1, 2);

Kung does not disclose explicitly “restricting usage”---“by particular individuals” (as recited in claim 26). This limitation is disclosed by Gainsboro, explicitly, as follows:

Gainsboro discloses “It would be highly desirable to provide an institutional telephone system that automatically prohibits inmates from attempting to call certain outside persons”, refer to paragraphs 0006; further discloses “revoke an inmate’s calling privileges”, refer to paragraphs 0007 and 0014.

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It would have been obvious to the person of ordinary skill in the art at the time of the invention "restricting usage"---"by particular individuals". This capability can be implemented by combining "institutional telephone system", as taught by Gainsboro into Kung's "IP central station". The motivation for using this capability is to mitigate harassment problem. The broadband network generally provides interconnection between a plurality of customer locations utilizing various interconnection architectures including Internet Protocol (IP) based network, various existing systems (legacy systems) such as the public switched telephone network (PSTN), ATM networks, the Internet, signaling networks, as well as other systems, refer to Kung's paragraph 0026).

For claims 2, 4, 13, and 16, Kung discloses "2. (Original) "wherein programming for said programmable control computer is distributed to at least one remote locations over said VoIP network (Kung discloses, "**distributed processing controller 306 which may be a microprocessor and/or one or more interconnected distributed processing modules for controlling the broadband residential gateway 300, refer to paragraph 0081)**. Further, Kung discloses Ethernet connection , **as recited by claim 13**, (interface or port connection), refer to paragraph 0027.

For claims 7 and 15, Kung discloses "wherein said off site switched telephone network is a Private Branch Exchange"(PBX 146 in fig. 1); and "a data exchange network interconnecting said sites over said Ethernet network", **as recited by claim 15, refer to PBX 146 in fig. 1 and paragraph 0027 for Ethernet LAN.**

For claim 14, Kung discloses “a plurality of said sites; said sites being interconnected over said Ethernet network, refer to LAN which is Ethernet based, refer to paragraph 0027.

For claims 23 and 27, wherein said VOIP gateway includes voice compression and packetization, **as recited by claims 23, and 27**, refer to Kung ‘558’s paragraph 0066 and 0080.

For claims ,32-33, 36, 41-43, 47-48 and 52-53, Kung discloses A call processing system for use in processing calls, **(The IP central station may be configured to store various control and system information such as location, address, and/or configurations of one or more broadband residential gateways 300, as well as other routing and call set-up information, refer to paragraph 0038);** said system comprising, :

- a plurality of telephone **terminals** **(These voice networks are referred to as a public switched telephone network (PSTN) or plain old telephone service (POTS), refer to paragraph 0003; Referring to FIG. 1, an exemplary embodiment of a broadband network 1. The broadband network generally provides interconnection between a plurality of customer locations utilizing various interconnection architectures including Internet Protocol (IP) based network, refer to paragraph 0026);**
- a voice over Internet protocol (VoIP) gateway coupled to said plurality of telephone terminals and disposed locally with respect thereto, said Voce gateway providing a digital data network interface providing digital communication of voice signals

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associated with one or more of said plurality of telephone terminals with user terminals, **as recited by claims 32 and 43**, (Refer to “gateway (BRG) 300.

Although the broadband residential gateway is preferably disposed in a residence for many aspects of the invention, in exemplary embodiments, it may also be disposed in a **business or other location**, **see paragraph 0027**. “Broadband residential gateway 300 may be connected to the remainder of the broadband network 1 using any suitable mechanism such as a **gateway directly into an IP network**”, **see paragraph 0079**).

- a processor-based system coupled to said VoIP gateway and disposed remotely with thereto, said processor-based system providing call control for controlling communications between said plurality of telephone terminals and said user terminals, **as recited by claim 32**, (Alternatively, the user may use system memory in IP central (processor) and buffer data remotely, refer to paragraph 0093).
- a programmable control computer (programming messages and/or computer data between the various devices, **as recited by claim 41 also**, refer to paragraphs 0036, 0037, 0055, for switching (paragraphs 0040,0044), accessing (paragraph 0006 and abstract), routing, **as recited by claims 33 and 48 also**, (paragraph 0037, 40, 44, and 57), timing (paragraph 0044, 48 and 67), billing, **as recited by claims 36 and 47**, (paragraph 35, 39 and 63), and the control of said telephones (figs. 2 and 3 and paragraphs 27 and 55), said telephones (106, 108, 110 and PSTN) being connected to said computer (200 in fig. 4);

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- terminals ---via public switched telephone network, **as recited by claim 42 also**, (160 in fig. 1, 2);
- wherein said centralized system provides call monitoring with respect to said call, **as recited by claim 52, (refer to Kung's reference: "The BRG 300 monitors whether the subscriber wants to connect to an incoming call or a call waiting on the queue at Step S750.**
- **as recited by claim 53**, wherein said call processing system is a prison telephone system (refer to Kung, "Although the broadband residential gateway is preferably disposed in a residence for many aspects of the invention, in exemplary embodiments, it may also be disposed in a business or other location", **see paragraph 0027).**

It would have been obvious to the person of ordinary skill in the art at the time of the invention "'prison facility"' . This capability can be implemented by combining "institutional telephone system", as taught by Gainsboro into Kung's "IP central station". The motivation for using this capability is to mitigate harassment problem and directs the computer control unit to prohibit similar calls in the future.

4. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kung et al** (US Patent Application No. 2003/0133558), hereinafter, Kung in view of **Gainsboro** (US Patent Application No. 2002/0071537), further, in view of **Hsiao** (US Patent No. 5,971,272).

For claim 31, Kung discloses "a controlled public telephone communications system, (The IP central station may be configured to store various control and system information such as location, address, and/or configurations of one or more broadband residential

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gateways 300, as well as other routing and call set-up information, refer to paragraph 0038; configured to manage voice information transfers---, refer to paragraph 0038); comprising,

- a plurality of telephones at a given site (The broadband network generally provides interconnection between a plurality of customer locations utilizing various interconnection architectures including Internet Protocol (IP) based network, refer to paragraph 0026);
- a programmable control computer (programming messages and/or computer data between the various devices, refer to paragraphs 0036, 0037, 0055), for switching (paragraphs 0040,0044), accessing (paragraph 0006 and abstract), routing, (paragraph 0037, 40, 44, and 57), timing (paragraph 0044, 48 and 67), billing, (paragraph 35, 39 and 63), and the restricted usage of said telephones (figs. 2 and 3 and paragraphs 27 and 55), said telephones (106, 108, 110 and PSTN) being connected to said programmable control computer (200 in fig. 4);
- an offsite public switched telephone network, (160 in fig. 1, 2);
- a Voice over Internet Protocol (VoIP), (analog voice may be converted to digital data and packetized for transmission in an appropriate output protocol such as an Internet protocol (IP), refer to paragraph 0028; further, discloses, “the IP central station 200 may also include, for example, one or more of the following gateways:--- a voice gateway (VG) 232, and/or a multimedia gateway (MG) 230. The IP central station 200 may utilize one or more of these gateways to provide centralized system intelligence and control of voice and/or data IP packets, refer to paragraph 0045 and VOIP telephony refer to paragraph 0041).); and

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- switching means for selectively connecting said telephones with said Voice over Internet Protocol network (VOIP) network, (Kung discloses, “programming messages and/or computer data between the various devices, refer to paragraphs 0036, 0037, 0055; “The central router 210 provides for example Ethernet switching and aggregate traffic between servers, gateways and the IP network 120 (Gateway is connected to various telephones, see fig. 1), and/or ATM network 185 backbone, refer to paragraph 0044); and further discloses analog voice may be converted to digital data and packetized for transmission in an appropriate output protocol such as an Internet protocol (IP), refer to paragraph 0028, 142, 144 and 120 in fig. 1));

Kung does not disclose explicitly “restricting usage”---“by particular individuals”. This limitation is disclosed by Gainsboro, explicitly, as follows:

Gainsboro discloses “It would be highly desirable to provide an institutional telephone system that automatically prohibits inmates from attempting to call certain outside persons”, refer to paragraphs 0006; further discloses “revoke an inmate’s calling privileges”, refer to paragraphs 0007 and 0014.

Kung in view of Gainsboro does not disclose the following limitation, which is disclosed by Hsiao, as follows:

- said programmable control computer further comprising a system responsive to a calling card number associated with a personal identification number (PIN), said

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numbers being keyed into said telephones for authorizing stored permitted telephone usage associated with individual number, (Hsiao discloses **Personal accounts are associated with, for example, telephone calling cards, checking and savings accounts in banks, computer networks, and credit cards. Typically, account security is maintained (and unauthorized access prevented) by use of a password or personal identification number (PIN), (refer to col. 1 lines 13-19). For example, a telephone calling card number may be provided by keying in the number on a telephone keypad or, in some circumstances, sliding the telephone calling card through a magnetic card reader attached to a specially equipped telephone. The account number is printed on the telephone calling card, and accordingly is readily accessible to any individual looking at the telephone calling card. However, merely knowing the account number does not allow someone to use the telephone calling card since a caller also has to know the PIN associated with the telephone calling card before a call may be placed using the telephone calling card. In theory, someone who steals the telephone calling card or merely knows the account number printed on the telephone calling card cannot make fraudulent telephone calls using the telephone calling card account because only the authorized user knows the PIN necessary to activate the account, (refer to col. 1 lines 35-50).**

It would have been obvious to the person of ordinary skill in the art at the time of the invention of "restricting usage"---"by particular individuals" and "said programmable control computer further comprising a system responsive to a calling card

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number associated with a personal identification number (PIN), said numbers being keyed into said telephones for authorizing stored permitted telephone usage associated with individual number". These capabilities can be implemented by combining "institutional telephone system", as taught by Gainsboro into Kung's "IP central station" and also Hsiao's system of entering calling card's numbers into telephone. The motivation for using this capability is to mitigate harassment problem. The broadband network generally provides interconnection between a plurality of customer locations utilizing various interconnection architectures including Internet Protocol (IP) based network, various existing systems (legacy systems) such as the public switched telephone network (PSTN), ATM networks, the Internet, signaling networks, as well as other systems, refer to Kung's paragraph 0026; and also ensure security of access to system by using PIN numbers.).

5. Claims 3 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kung in view of Gainsboro, as above, further, in view of **Cell Jr. (US Patent No. 6,876,647), hereinafter, Cell.**

For claims 3 and 22, Kung in view of Gainsboro discloses all the limitations of subject matter with the exception of the following limitation, which is disclosed by Cell, as follows:

- wherein said programmable control computer further comprises a VoIP gateway for servicing and control of VoIP communications over said VoIP network (A machine readable storage, having stored thereon a computer program for streaming voice data, ---to perform the steps of: establishing a plurality of voice call connections with a voice over IP (VoIP) gateway), refer to claim 17 of Celi).

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It would have been obvious to the person of ordinary skill in the art at the time of the invention to use programmable control computer further comprising a Voice gateway for servicing and control of Voice communications. This capability can be implemented by combining VOIP gateway into IP central station. The motivation for using VOIP gateway in IP central station is to establish a voice call connection with a VoIP gateway; and receiving audio data from a network source.

6. Claims 4 and 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kung** in view of **Gainsboro**, as above, further, in view of **Vo et al (US Patent No. 6,795,444)**, **hereinafter, Vo**.

For claims 4 and 5, Kung in view of Gainsboro discloses all the limitations of subject matter, including the limitation, **as recited by claim 4, (see page 6 of office action)**. Vo also discloses the limitations of claim 4, as follows:

- a plurality of said given sites (270 and 272); at least one programmable control computer (MCU 280) at each site; said sites being interconnected over said Voip network (108), **as recited by claim 4**, refer to fig. 2A.

Kung in view of Gainsboro does not disclose explicitly the following limitations of claim 5, which are disclosed by VO, as follows:

- a data exchange network interconnecting said sites, said telephone communications systems being integrated into said data exchange network, **as recited by claim 5**, (hubs/bridges 286A through 286D).

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It would have been obvious to the person of ordinary skill in the art at the time the invention to use a plurality of said given sites (270 and 272); at least one programmable control computer (MCU 280) at each site; said sites being interconnected over said Voip network (108). This capability can be implemented by combining programmable computer in each station. The motivation for using VOIP is to establish a voice call connection with a VoIP gateway; and receiving audio data from a network source.

7. Claims 8 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable **Kung'558** in view of **Gainsboro**, further, in view of **Kung et al** (US Patent No. 6,816,469), hereinafter, **Kung'469**

For claims 8 and 18, Kung'558 discloses all the limitations of subject matter with the exception of the following limitation, which is disclosed by a Gainsboro, as follows:

“imposing a three way call restriction”, (**Gainsboro discloses “It would be highly desirable to provide a method --for allowing a recipient of an undesired call from an inmate to easily and automatically prohibit all future calls from that particular inmate, refer to Gainsboro's paragraph 0006).**

It would have been obvious to the person of ordinary skill in the art at the time the invention to use a imposing a three way call restriction. This capability can be implemented by combining it in IP central station, as taught by Kung'558. The motivation for using VOIP is to establish a voice call connection and receiving audio data from a network source.

For claim 19, Kung'558 disclose the following limitations:

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- wherein said VOIP gateway (300 in fig. 1) is disposed between said telephone and said VOIP network (refer to paragraph 0041); and a second VOIP gateway (230 in fig. 2) between said VOIP network and said offsite public switched telephone network, refer to fig. 2 and paragraph 0041).

8. Claims 9, 21, 35, 49 and 55-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kung'558 in view of Gainsboro**, as above, further in view of **Kung et al** (US Patent No. 6,687,360), hereinafter, Kung'360.

For claims 9, 21, 35, 49 and 55-58, Kung'558 in view of Gainsboro discloses all the limitations of subject matter with the exception of the following limitation, which is disclosed by Kung'360, as follows:

- wherein said programmable control computer comprises: a system responsive to personal identification numbers (PIN keyed into said telephones for authorizing stored permitted telephone usage associated with individual PIN numbers (**the subscriber dials a toll-free number for location registration using either a PIN or some other personal information that uniquely identifies the subscriber, refer to col. 29 lines 45-60.**

It would have been obvious to the person of ordinary skill in the art at the time the invention to use the capability of a system responsive to personal identification numbers (PIN keyed into said telephones. This capability can be implemented by combining it in IP central station, as taught by Kung'558. The motivation for using VOIP is to identify the caller and establish a voice call connection and receiving audio data from a network source.

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9. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kung'558, and in view of Gainsboro, as above**

For claims 10 and 11, Kung'558 discloses the following limitation:

- wherein said gateway is an internal gateway, **as recited by claim 10**; and wherein said gateway is an external gateway shared with other Voice devices outside of said control computer, **as recited by claim 11, (Kung '558 discloses “a gateway such as the head-end hub (HEH) 115. The head-end hub 115 may be variously configured to provide various services and/or interconnections with the rest of the broadband network 1”, refer to paragraph 0029).**

10. Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kung558, in view of Gainsboro and Cell Jr. (US Patent No. 6,876,647), hereinafter, Cell**, further, in view of, **Weitz (US Patent No. 6,445,682)**.

For claim 28, Kung558 and Cell disclose all the limitations of subject matter with the exception of the following limitation, which is disclosed by Weitz, as follows:

- wherein a second VOIP gateway includes decompression and depacketization, **as recited by claim 28, refer to Weitz,'s col. 44 line 45 through col. 45 line 15.**

It would have been obvious to the person of ordinary skill in the art at the time the invention to use the capability of decompression and depacketization . This capability can be implemented by combining into IP central station. The motivation for using packetization is to

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establish a voice call connection with a VoIP gateway; and receiving audio data from a network source.

For claim 29, Kung'558 discloses, " VOIP gateway includes an Ethernet network interface, **as recited by claim 29**, refer to Kung's paragraph 0027.

11. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kung558 in view of Gainsboro, Cell, and Weitz**, as above, further, in view of **Pogossiants et al** (US Patent Application No. 2001/0028649), hereinafter, '649.

For claim 30, Kung558 disclose all the limitations of subject matter with the exception of the following limitation, which is disclosed by Gainsboro, as follows:

* imposing a third party call restriction", (**Gainsboro discloses "It would be highly desirable to provide a method ---for allowing a recipient of an undesired call from an inmate to easily and automatically prohibit all future calls from that particular inmate, refer to Gainsboro's paragraph 0006).**

Kung 558, Gainsboro, Cell and Weltz disclose all the limitations of subject matter with the exception of the following limitation, which is disclosed by '649, as follows:

- a third party call detection system; and a public switched telephone network, said third party call detection system being between said second VOIP gateway and said public switched telephone network, refer to fig. 6, paragraphs 0025 and 0090).

It would have been obvious to the person of ordinary skill in the art at the time the invention to use the capability of a third party call detection system; and a public switched telephone network, said third party call detection system being between said second VOIP

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gateway and said public switched telephone network. This capability can be implemented by combining it into IP central station. The motivation for using packetization is to establish a voice call connection with a VoIP gateway; and receiving audio data from a network source.

12. Claims 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable Kung'558, over Gainsboro, as above, further, in view of **Pogossiants et al** (US Patent Application No. 2001/0028649), hereinafter, '649.

For claims 20 and 30, Kung'558, in view of Gainsboro disclose all the limitations of subject matter with the exception of the following limitation, which is disclosed by '649, as follows:

- wherein said three-way call detection is performed between said second VOIP gateway (PBX telephony switch, refer to paragraph 0025) and said public switched telephone network 617, refer to fig. 6, paragraphs 0025 and 0090).

It would have been obvious to the person of ordinary skill in the art at the time the invention to use capability of third party call detection. This capability can be implemented by combining it in IP central station, as taught by Kung'558. The motivation for using VOIP is to establish a VOIP telephone calling.

13. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kung'558 in view of Gainsboro, as above, further, in view of **Weitz** (US Patent No. 6,445,682)

For claims 24 and 25, Kung'558 in view of Gainsboro disclose all the limitations of

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subject matter with the exception of the following limitation, which is disclosed by Weitz, as follows:

- wherein said second Voce gateway includes decompression and depacketization, refer to col. 44 line 45 through col. 45 line 15.
- wherein said VOIP gateway includes an Ethernet network interface, refer to col. 44 line 45 through col. 45 line 15.

It would have been obvious to the person of ordinary skill in the art at the time the invention to use capability of Voce gateway includes decompression and depacketization and VOIP gateway includes an Ethernet network interface. This capability can be implemented by combining it in IP central station, as taught by Kung'558. The motivation for using VOIP is to establish a VOIP telephoning calling.

14. Claims 34, 37, 39, 44-45 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kung'558, over **Gainsboro, as above, further, in view of Gainsboro** (US Patent No. 6,611,583).

For claims 34, 37, 39, 44-45 and 50, Kung'558 in view of Gainsboro '537 discloses all the limitations of subject matter with the exception of the following limitation, which are disclosed by Gainsboro''583, as follows:

- wherein said call control provided by said processor-based system comprises telephone usage restriction checking, **as recited by claim 34**, (refer to col. 7 lines 17-42).

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- wherein said call control provided by said processor-based system comprises call monitoring, **as recited by claim 37**, (refer to col. 7 lines 17-42.
- wherein said call fraud detection comprises three-way call detection, **as recited by claims 39, 44-45, and 50**, (refer to col. 6 line 53-col. 7 line 15.

It would have been obvious to the person of ordinary skill in the art at the time the invention to use capability of call control provided by said processor-based system comprises telephone usage restriction checking, monitoring and three way call detection. This capability can be implemented by combining it in IP central station, as taught by Kung'558. The motivation for using VOIP is to establish a VOIP telephoning calling.

15. Claims 38-39 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kung'558**, in view of Gainsboro, further, in view of **Peel et al** (US Patent No. 5,907,602).

For claims 38, 39 and 51, Kung'558 in view of Gainsboro discloses all the limitations of subject matter with the exception of the following limitation, which are disclosed by Peel, as follows:

- wherein said call control provided by said processor-based system comprises call fraud detection, **as recited by claim 38**, refer to col. 33 lines 14 –24.
- wherein said call fraud detection comprises three-way call detection **as recited by claim 39 and 51**, refer to col. 33 lines 14 –24.

It would have been obvious to the person of ordinary skill in the art at the time the invention to use capability of call control provided by said processor-based system comprises call fraud detection, . This capability can be implemented by combining it in IP central station,

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as taught by Kung'558. The motivation for using VOIP is to establish a VOIP telephoning calling.

16. Claims 40 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kung et al**, hereinafter, Kung'558, in view of **Ziegler et al** (US Patent Application No.2003/0023714), hereinafter, Zeigler.

For claims 40 and 46, Kung'558 discloses all the limitations of subject matter with the exception of the following limitation, which are disclosed by Zeigler, as follows:

- wherein said processor-based system provides real time call recording, refer to paragraph 0013.

It would have been obvious to the person of ordinary skill in the art at the time the invention to use capability of processor-based system provides real time call recording. This capability can be implemented by combining it in IP central station, as taught by Kung'558. The motivation for using VOIP is to establish a VOIP telephoning calling.

Allowable Subject Matter

17. Claim 54 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

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18. Applicant's arguments filed 6/22/2007 have been fully considered but they are not persuasive.

Applicant argues, "It is well settled that "[t]he examiner bears the initial burden of factually supporting any prima facie case of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. § 2142. To make a prima facie case of obviousness, the Examiner must determine the "scope and content of the prior art," ascertain the "differences between the prior art and the claims at issue," determine "the level of ordinary skill in the pertinent art," and evaluate evidence of secondary considerations. *Graham v. John Deere*, 383 U.S. 1, 17, (1966); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. __ (2007); see also M.P.E.P. § 2141. When determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(0.

The Supreme Court in *KSR* stated that it is "important [for an examiner] to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S. April 30, 2007). The Court indicated that there should be an "explicit" analysis regarding "whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *Id.* (emphasis added). Further, the Court did not reject the use of "teaching, suggestion, or motivation" test as a factor in the obviousness analysis, but rather stated that this test may be indicative of non-obviousness under 35 U.S.C. § 103. *Id.* at 14-15".

In response to applicant's argument that Kung'558 and Gainsboro prior art are nonanalogous art, examiner states that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case,

- Kung'558 recites all of the limitations of independent claims, such as, "a programmable control computer (programming messages and/or computer data between the various devices, refer to paragraphs 0036, 0037, 0055, for switching (paragraphs 0040,0044), accessing (paragraph 0006 and abstract); routing, (paragraph 0037, 40, 44, and 57), timing (paragraph 0044, 48 and 67), billing, (paragraph 35, 39 and 63), and the controlling usage of said telephones (figs. 2 and 3 and paragraphs 27 and 55), said telephones (106, 108, 110 and PSTN) being connected to said computer (200 in fig. 4);
- **As recited by claim 26, a Voice over Internet Protocol (VoIP) gateway for transmitting signals from said telephones into data packets transmitted over----- said control computer, (analog voice may be converted to digital data and packetized for transmission in an appropriate output protocol such as an Internet protocol (IP), refer to paragraph 0028; further, discloses, "the IP central station 200 may also include, for example, one or more of the following gateways:--- a voice gateway (VG) 232, and/or a multimedia gateway (MG) 230. The IP central station 200 may utilize one or more of these gateways to provide centralized**

- system intelligence and control of voice and/or data IP packets, refer to paragraph 0045 and VOIP telephony refer to paragraph 0041).); and**
- switching means operable under control of said programmable computer for selectively connecting said telephone instruments with said Voice over Internet Protocol network (VOIP) network , wherein said telephones are connected to said public switched telephone network only under control of said programmable control computer, **(Kung discloses, “programming messages and/or computer data between the various devices, refer to paragraphs 0036, 0037, 0055; “The central router 210 provides for example Ethernet switching and aggregate traffic between servers, gateways and the IP network 120 (Gateway is connected to various telephones, see fig. 1), and/or ATM network 185 backbone, refer to paragraph 0044); and further discloses analog voice may be converted to digital data and packetized for transmission in an appropriate output protocol such as an Internet protocol (IP), refer to paragraph 0028, 142, 144 and 120 in fig. 1));**
 - a processor-based system coupled to said VoIP gateway and disposed remotely with thereto, said processor-based system providing call control for controlling communications between said plurality of telephone terminals and said user terminals external to said prison facility, **(Alternatively, the user may use system memory in IP central (processor) and buffer data remotely, refer to paragraph 0093).**
 - an offsite public switched telephone network, **as recited by claims 6, and 17, (160 in fig. 1, 2);**

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In all independent claims 1, 12, 26, 32, the broadband network generally provides interconnection between a plurality of customer locations utilizing various interconnection architectures including Internet Protocol (IP) based network, various existing systems (legacy systems) such as the public switched telephone network (PSTN), ATM networks, the Internet, signaling networks, as well as other systems, refer to Kung's paragraph 0026). Kung, therefore, is explicitly pertinent to the claimed limitations.

Applicant argues, "Dependent Claims 2, 4, 6, 7, 10, 11, 13-17, 23, and 27 As noted above, the combination of Kung '558 with Gainsboro '53 7 is improper. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 2, 4, 6, 7, 10, 11, 13-17, 23, and 27. Moreover, each of these dependent claims recites additional features not taught or suggested by the applied art.

For example, claim 2 recites that the "programming for said programmable control computer is distributed to at least one remote location over said VoIP network." The Examiner relies upon Kung '558's distributed processing controller (306) as meeting these elements. Office Action at p. 6. However, distributed processing controller (306) only controls broadband residential gateway (300). Kung '558 at ¶ [0081]. Distributed processing controller (306) is not the programmable control computer, nor does it contain programming for the programmable control computer, which the Examiner has previously contended is met by Kung

In response, examiner states that **distributed processing controller 306 which may be a microprocessor and/or one or more interconnected distributed processing modules distributed according to the need. It is not concentrated in one place.**

Claim 10 recites that "said gateway is an internal gateway," and claim 11 recites that "said gateway is an external gateway shared with other VoIP devices outside of said programmable control computer." The Examiner relies solely upon Kung '558's head-end hub (115) as meeting these claimed elements. Office Action at pp. 13 and 14. However, Applicant has been unable to find any indication in Kung '558 that its head-end hub (115) is an internal gateway or an external gateway shared with other VoIP devices outside of a programmable control computer, and the Examiner has not shown otherwise. Further, the Examiner does not rely upon Gainsboro '537 as teaching or suggesting these claimed elements, and Applicant asserts that it does not to do so. Therefore, the combination of Kung '558 with Gainsboro '537 does not teach or suggest every feature recited in claims 10 and 11. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 10 and 11.

In response, examiner states that Kung '558 discloses "a gateway such as the head-end hub (HEH) 115. The head-end hub 115 may be variously configured to provide various services and/or interconnections with the rest of the broadband network 1", refer to paragraph 0029.

Applicant argues, "Claim 32 recites, in part, "a plurality of telephone terminals disposed at said prison facility, wherein access to said plurality of telephone terminals is provided by said prison facility

" In support for this rejection, the Examiner has stated that because Kung '558 discloses a system may be deployed in "a business or other location," Kung '558's system may also be used in a "prison facility." Office Action at p. 9. Even assuming, arguendo, that prison facilities are

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encompassed by Kung '558's "other locations," that alone is not sufficient to establish a prima facie case of obviousness. Here, Kung '558's system would not be suitable for use in a prison facility, which presents unique challenges unlike those found in a generic location. See e.g., Specification, page 2, lines 6-15; page 3, line 8--page 4, line 9. Therefore, although Kung '558's system may be deployed in "a business or other location," there is no indication that its system would be successfully implemented in a "prison facility."

Examiner states that "other locations" imply any other location regardless of "prison facility". However, Gainsboro discloses explicitly "prison facility", refer to paragraph 0001.

Applicant argues, "it is believed that claim 31 remains allowable".

Examiner responds that claim 31 has now been rejected vis updated search.

In light of above explanation, arguments by applicant are not persuasive.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Inder P. Mehra whose telephone number is 571-272-3170. The examiner can normally be reached on Monday through Friday from 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Inder Pal Mehra 9/3/07
Inder P Mehra
Examiner
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